

REMARKS

Claims 40-59 are pending in the Application.

Claims 40-59 stand rejected.

I. REJECTIONS UNDER 35 U.S.C. § 112

Claims 40, 43 and 56 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner has asserted that the term "typical" on line 15 of claim 40 is not clearly defined.

In response, Applicants respectfully traverse this rejection. The term "typical" as it pertains to caller ID information is specifically defined within the Specification. On page 19, lines 8-10, it is stated that "typical caller ID information will be assumed to contain the ten-digit telephone number of the calling party and/or the name of the person or business originating the call." This definition for "typical caller ID data" is further stated on page 26, lines 17-18. Furthermore, the Examiner is directed to claims 43, 53, and 56. As a result, Applicants respectfully assert that the term "typical" is clearly defined in the Application.

Likewise, Applicants respectfully traverse the rejection of claims 55 and 57, where the Examiner has asserted that the term "non-typical" is not clearly defined. Again, Applicants respectfully refer the Examiner to the foregoing portions of the Specification where *typical* caller ID data or messages are defined. Thus, "non-typical" caller ID information would not contain the phone number and/or name of the calling party.

Claim 49 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to convey to one skilled in the relevant art that the inventors at the time the application was filed had possession of the claimed invention. More specifically, the Examiner has asserted that the phrase "retrieving the message to a second caller ID" on line 7 of claim 49 is confusing. Applicants respectfully traverse this rejection. Line 7 of claim 49 actually recites "retrieving the message to a second caller ID modem in said system; and." Applicants do not understand

why the Examiner truncated this sentence by leaving off the language "modem in said system," which provides further explanation as to what is being recited within this claim limitation. The sending of the non-typical caller ID data is performed by system 100 using caller ID modems in DSP 309 to send data out to the analog telephone. This is further described on page 26 of the Specification. As a result, Applicants respectfully assert that the rejection of claim 49 is sufficiently traversed.

II. DOUBLE PATENTING

Claims 44 and 54 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 12 of U.S. Patent No. 6,067,349. Applicants respectfully traverse this rejection. First, since claims 44 and 54 are dependent claims, it is not proper to reject them under a double patenting rejection unless the claims from which they depend are also rejected for double patenting. Secondly, claims 44 and 54 recite that the message does not include typical caller ID information. This limitation is not recited in claim 12 of Patent No. 6,067,349. Therefore, claims 44 and 54 do not claim the same invention of claim 12 of Patent No. 6,067,349.

Claim 46 stands rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 4 of U.S. Patent No. 6,252,944. Applicants respectfully traverse this rejection. Again, as asserted above with respect to claims 44 and 54, claim 46 is a dependent claim, and thus it is improper to have a double patenting rejection of claim 46 without also having the same double patenting rejection of the claims from which claim 46 depends from. Additionally, claim 46 also recites that the message does not include typical caller ID information. Claim 4 of Patent No. 6,252,944 does not recite this limitation. Therefore, claim 46 of the present application and claim 4 of Patent No. 6,252,944 do not claim the same invention.

Claim 47 stands rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 1 of U.S. Patent No. 6,252,944. Applicants respectfully traverse this rejection. Again, as asserted above with respect to claims 44 and 54, claim 47 is a dependent claim,

and thus it is improper to have a double patenting rejection of claim 47 without also having the same double patenting rejection of the claims from which claim 47 depends from. Additionally, claim 47 also recites that the message does not include typical caller ID information. Claim 1 of Patent No. 6,252,944 does not recite this limitation. Therefore, claim 47 of the present application and claim 1 of Patent No. 6,252,944 do not claim the same invention.

III. REJECTIONS UNDER 35 U.S.C. § 102

Claims 40-43, 45, 48, 50-53 and 55-58 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Kim* (U.S. Patent No. 5,970,128). In response, Applicants respectfully traverse these rejections.

As the Examiner is well aware, for a claim to be anticipated under § 102, each and every element of the claim must be found within the cited prior art reference.

With respect to claims 40, 43, 49, 53, 55, and 56, Applicants respectfully assert that *Kim* teaches away from the present invention. These claims recite that the message does not include typical caller ID information. As asserted above, typical caller ID information is defined within the Application as including the name and/or telephone number of the calling party. The Examiner has asserted that *Kim* teaches that the CID data packet includes other information such as the month, date, hour and minute of the incoming call, and that this is not typical caller ID information. First, Applicants respectfully traverse such an assertion in that it is known that caller ID information does naturally include the time and date at which the call was received, along with the name and phone number of the incoming call. Nevertheless, *Kim* specifically teaches that such CID data does include the telephone number and the name of the calling party. In contrast, the rejected claims specifically recite that the message does not include such typical caller ID information. Therefore, for *Kim* to anticipate these claims, even under the Examiner's argument, such CID information in *Kim* would have to *exclude* the telephone number and name of the incoming call, and this is not what is taught in *Kim*. Therefore, Applicants assert that *Kim* does not, and cannot, anticipate these rejected claims.

With respect to claim 45, the Examiner has asserted that it is inherent that the switching circuitry and the voice processing circuitry are controlled by a single processing means. Applicants respectfully traverse this inherency argument by the Examiner, thus requiring the Examiner to support such an assertion with objective evidence. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *Id.*

With respect to claim 48, the Examiner has asserted that *Kim* teaches that the stored program of *Kim* is the claimed single set of software. Applicants respectfully traverse. First of all, the Examiner has not addressed all of the language within claim 48, and has instead ignored the portion of claim 48 that recites “operable for controlling both the switching circuitry and the voice processing circuitry.” For this reason alone, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of anticipation. Furthermore, the teachings of *Kim* do not disclose a single set of software operable for controlling both the switching circuitry and the voice processing circuitry, which are controlled by a single processing means in the system. In fact, the “stored program” referred to by the Examiner is actually the Stored Program Control Switching systems used by telephone companies to provide switching of telephone calls. Nowhere is it taught that such SPCSs include voice processing circuitry.

IV. CONCLUSION

As a result of the foregoing, Applicants respectfully assert that all of the claims in the Application are in condition for allowance.

Respectfully submitted,

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